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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/612,635  | 07/02/2003  | Adolf Adrian         | 102792.60601US      | 3661             |
| 23911 7590 10/09/2008<br>CROWELL & MORING LLP<br>INTELLECTUAL PROPERTY GROUP<br>P.O. BOX 14300<br>WASHINGTON, DC 20044-4300 |             |                      |                     |                  |
| EXAMINER  |             |                      |                     |                  |
| BURCH, MELODY M   |             |                      |                     |                  |
| ART UNIT  |             | PAPER NUMBER         |                     |                  |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/612,635

**Applicant(s)**

ADRIAN ET AL.

**Examiner**

Melody M. Burch

**Art Unit**

3657

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 5 and 7-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5 and 7-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Objections***

1. Claims 5 and 7-11 are objected to because of the following informalities:
  - The second instance of the phrase "a lipped seal" (see lines 11-12 of claim 5) should be changed to --said lipped seal-- or --the lipped seal-- in the independent claims 5 and 11 to properly refer back to the first recitation of the phrase "a lipped seal."
  - The phrase "a conical surface" in line 2 of claim 8 is objected to and should be changed to --said conical surface-- or --the conical surface-- to refer back to the conical surface recited in claim 5.
  - The phrase "at top" in line 2 of claim 10 should be reworded for grammatical purposes. Examiner notes that in line 2 from the bottom of claim 11 Applicant used the term "atop."

Appropriate correction is required. The remaining claims are objected to due to their dependency from claim 5.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 5 and 7-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over GB-2115903 (GB'903) in view of US Patent 5533598 to Adrian et al. and US Patent 4189033 to Katsumori.

Re: claims 5 and 10. GB'903 shows in figure 1 a sealing and guiding arrangement for passage of a piston rod 3 in a two-cylinder dashpot and for sealing and guiding the piston rod when traveling into and out of the dashpot, comprising: at least one seal 25 for sealing the interior of the dashpot from the outside; at least one radial guide 6 for the piston rod; the two cylinder dashpot having an inner cylinder 1 and an outer cylinder 4, a gas chamber 5 between the outer cylinder and the inner cylinder, a gas channel 28,10,14 extending between the radial guide and the gas chamber, a check valve 19,20 in the gas channel in upstream of the gas chamber as shown and formed as a lipped seal comprising a flow through recess 10,16, a lipped seal 19,20 comprising an elastically-tensioned ring 19 with a cross-section and a sealing lip shown to the left and above the end of the lead line of number 20, the recess being formed in a sealing seat under the ring, the sealing lip resting against a surface of the recess holding the seal.

GB'903 is silent as to the shape of the elastically tensioned element.

Adrian et al. teach in figure 2 the use of an elastically tensioned element 16 forming a part of a check valve being in the form of a circular ring with substantially circular-shaped cross-section as shown at part 16a and also including a sealing lip shown at part 16b.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the shape of the elastically-tensioned element of GB'903 to have been circular with a substantially circular shaped cross section, as taught by de Adrian et al., in order to provide a means of achieving a particular fluid flow pattern based on the seal shape as determined by routine experimentation and particular application.

Examiner also notes that in *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966) the court held that the configuration of a claimed object was a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration was significant. Examiner also notes that Applicant lacks an explanation of criticality for the particularly claimed shape of the elastically tensioned element.

GB'903, as modified, is also silent with regards to the surface of the recess holding the seal being a conical surface.

Katsumori teaches in figure 2 the use of a seal lip 14b resting against a conical surface 9b of a guide 9 in a piston cylinder arrangement for fluid flow control purposes.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the surface against which the seal of GB'903, as modified, rests to have included a conical surface, as taught by Katsumori, in order to provide a means of creating a more effective seal and a means of creating a wedging effect for non-return purposes.

Re: claims 7, 8, and 11. GB'903, as modified, teaches in figure 1 of GB'903 the limitation of a bushing 7 mounted on an inner surface of the guide for radially securing the piston rod. With regards to the rejection of claim 11 also see the rejection of claim 9 below.

Re: claim 9. GB'903, as modified, teaches in figure 1 of GB'903 an auxiliary seal 27 for sealing the sealing and guiding arrangement from the outer cylinder.

### ***Response to Arguments***

4. Applicant's arguments, see pg. 8 of the remarks, filed 6/16/08, with respect to the rejection(s) of claim(s) 5-11 under 35 USC 103 using the de Baan reference have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Adrian et al. and Katsumori.

### ***Conclusion***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melody M. Burch whose telephone number is 571-272-7114. The examiner can normally be reached on Monday-Friday (6:30 AM-3:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Siconolfi can be reached on 571-272-7124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

mmb  
October 8, 2008

/Melody M. Burch/  
Primary Examiner, Art Unit 3657